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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,161	01/19/2001	Michael S. Colman	MCA-538	9144

7590

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EXAMINER

MENON, KRISHNAN S

ART UNIT

PAPER NUMBER

1723

DATE MAILED: 05/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

VIR

<b>Office Action Summary</b>	<b>Application No.</b> 09/766,161	<b>Applicant(s)</b> COLMAN, MICHAEL S.	
	<b>Examiner</b> Krishnan S. Menon	<b>Art Unit</b> 1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 5-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

Claims 1-3 and 5-13 are pending as of the RCE of 8/11/04

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-3 and 5-8 rejected under 35 U.S.C. 102(a) as being anticipated by  
"Multiscreen PCR Plates User Guide", Millipore Corp., 4/2000. (IDS of 12/16/04)  
(Henceforth: User Guide).

User guide teaches improved recovery of double-stranded DNA of fragment lengths less than 300 base-pairs using the Multiscreen-384-plate filter (same filter used by applicant in the examples), with 1/5th dilution and with constant pressure differential of about 10 inches of mercury. The dilution agent is water or TE buffer. User guide does not specifically teach fragments of 300 base pairs, but this is inherent in the PCR products and the use of the Multiscreen-384-plate. Under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the

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prior art device. When the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the claimed process. In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986)

2. Claims 1,3,5-8 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by WO 01/19482.

WO'482 teaches a process for the improved recovery of double-stranded DNA by diluting the sample with water and then subjecting it to constant pressure filtration at a first and then a second pressure – page 5, lines 7-19; page 10 lines 10-30.. About the DNA having less than 300 base pairs, see page 2 lines 1-2 (nucleotide is the same as base pair). Re filtering the sample to dryness, this is implied because the filtration is conducted to remove all contaminants, which includes water (page 5 lines 30-32). Also see wells appear empty – page 10 lines 20-22.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over 'User Guide' in view of "Use of Multiscreen Plates for the preparation of bacterial DNA suitable for PCR ("Use of Multiscreen").

User guide teaches improved recovery of double-stranded DNA of fragment lengths less than 300 base-pairs using the Multiscreen-384-plate filter (same filter used by applicant in the examples), with 1/5th dilution and with constant pressure differential of about 10 inches of mercury. The dilution agent is water or TE buffer. User guide does not specifically teach fragments of 300 base pairs, but this is inherent in the PCR products and the use of the Multiscreen-384-plate (In re King). Instant claims differ from the teaching of User Guide in the 'increasing the concentration of said contaminants by adding ...monovalent cations'. Use of Multiscreen teaches adding monovalent and divalent cations (Mg for example) for recovering DNA as a routine procedure (page 283). It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching of 'Use of Multiscreen' in the teaching of User Guide to increase the recovery of DNA fragments as taught by 'Use of Multiscreen'.

### ***Response to Arguments***

Applicant's arguments with respect to the instant claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

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This action is in response to an RCE and is made non-final because of the new grounds for rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S. Menon whose telephone number is 571-272-1143. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'KS Menon', with a stylized, cursive script.

Krishnan S. Menon  
Patent Examiner  
5/19/05